REMARKS

In the present Amendment, claim 11 has been amended to recite a more preferred glass transition temperature (Tg) range. Support for the amendment may be found, for example, at page 49, last full paragraph of the specification. No new matter has been added, and entry of the Amendment is respectfully requested.

Upon entry of the Amendment, claims 1-18 will be pending.

In Paragraph No. 3, claims 1-18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kodama et al.

Applicants submit that this rejection should be withdrawn because Kodama et al does not disclose or render obvious the positive resist composition of the present invention.

The positive resist composition of the present invention includes an acid decomposable resin having a specific structure and a glass transition temperature in a specific range (70 to 155 C), and a specific, mixed organic solvent.

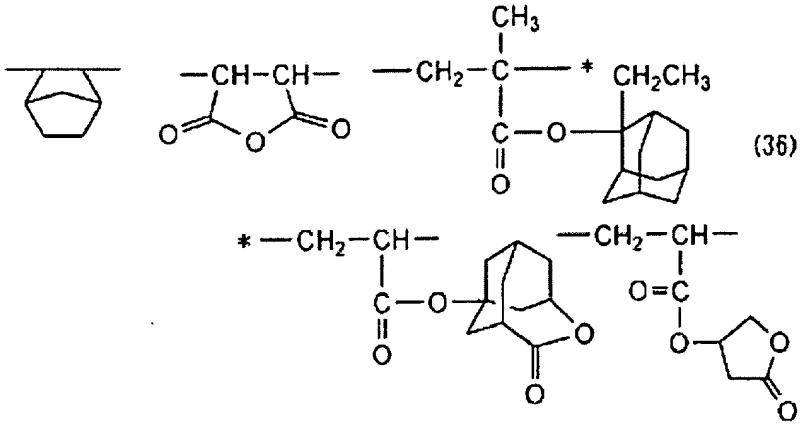
Kodama et al. does not identically disclose or fairly suggest the specific combination of the present invention.

The Examiner points to Kodama et al's resins (36) and (34), stating:

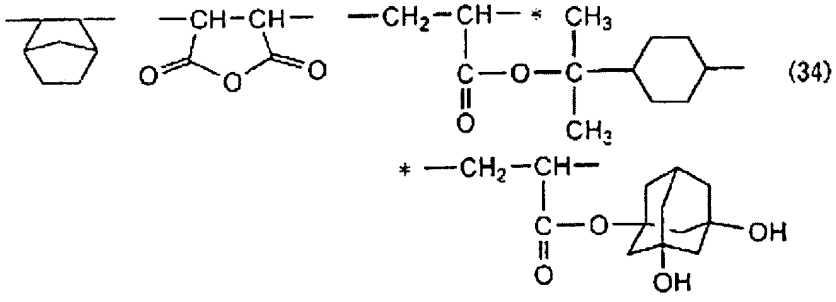
> Furthermore, the reference presents a number of suggested resins such as resin 36, which meets the claim limitations with the exception of the adamantyl group which is substituted with an ethyl group in the "1" position which does not meet the limitations of AII. However, in section [0114] these monomers are taught to be equivalent to those having substituents in the instantly claimed position. One such monomer is employed in a resin having similar repeat units to that of 36. In resin 34, a monomer meeting the limitations of AII is employed, and it would have been obvious to one of ordinary skill in the art to prepare resin 36 choosing to

employ the adamantyl group containing monomer of 34 in the place of 36 as they are taught by the reference to be equivalent.

Kodama et al's resin (36) in view of Kodama's resin (34) does not fairly suggest (or render obvious) the presently recited resin. The adamantyl group containing monomer of resin (34) of Kodama et al is not entirely disclosed in the paragraph [0114] of Kodama et al. The structures of resin (34) and resin (36) are shown below:



(36)



(34)

Applicants have advised that if the third repeating unit from the left of resin (36) were to be replaced with the first repeating unit from the right of resin (34), as suggested by the Examiner, the thus-substituted resin (36) would lose its acid decomposition function. The substituted resin (36) would lose its acid decomposition function because the third monomer

from the left of un-modified resin (36) is an acid decomposable repeating unit, and the modified resin would not function as an acid decomposable resin without this repeating unit. Thus, the substituted or modified Kodama et al resin (36) suggested by the Examiner would not correspond to the resin defined in the present claims, which is "capable of increasing its solubility in an alkali developer under action of an acid." See claim 1. In other words, Kodama et al's modified resin (36) would not function as a resist of the present invention, and any effect cannot be obtained.

The Examiner also points to resins 6, 7, 13 and 14 of Kodama et al, stating:

> Furthermore, it would have been obvious . . . to add a lactone moiety which is preferred by the reference to any of monomers 6, 7, 13, or 14.

With due respect, resins 6, 7, 13 and 14 do not disclose or fairly render obvious the presently recited resin. The present claims expressly require "at least one kind of acrylate derivative repeating units. . . ." As Applicants have noted in past Responses, their resin must include at least one kind of acrylate-based repeating unit. Methacrylate-based repeating units will not satisfy this requirement. The repeating units in Kodama et al's resins 6, 7 and 13 are all methacrylate-based repeating units. For at least this reason, Kodama et al's resins 6, 7 and 13 do not disclose or render obvious the presently claimed resist composition.

As to Kodama et al's resin 14, the Examiner's reliance is misplaced -- Applicants have already presented Declaration evidence establishing that the Tg of Kodama et al's resin 14 is outside the scope of the presently recited range of 70-155 C. See Mr. Nishiyama's Declaration Under 37 C.F.R. § 1.132 filed January 13, 2006.

Finally, Kodama et al does not disclose or fairly suggest the presently recited Tg requirement for the resin of the invention. The Examiner concedes that Kodama et al is silent with respect to a preferred Tg for the resin, but asserts that

> given that the resins/monomers taught by the reference are virtually the same as those instantly claimed, it is the position of the examiner absent evidence to the contrary, the resins of the reference meet the limitation.

For the reasons set forth above and in prior Responses, the resins of Kodama et al are not "virtually the same" as those presently claimed. In addition, as to the one Kodama et al resin -- Resin 14 -- which does appear to satisfy the structural recitations of the present claims, Applicants have already presented Declaration evidence that this particular resin of Kodama et al does not satisfy the Tg requirement of the present claims. See Mr. Nishiyama's Declaration, cited above. Thus, evidence to the contrary of the Examiner's position has already been presented.

In view of the above, reconsideration and withdrawal of the § 103(a) rejection of claims 1-18 based on Kodama et al are respectfully requested.

In Paragraph No. 4, claims 1-18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sato et al (6,787,282).

Sato et al '282 is prior art solely under 35 U.S.C. § 102(e), as of its U.S. filing date of September 25, 2002.

Sato et al's prior publication (US 2003/0108809) is prior art under section 102(a) as of its publication date of June 12, 2003, and under section 102(e) as of Sato et al's U.S. filing date of September 25, 2002.

Sato et al's prior publication's section 102(a) date of June 12, 2003 is later in time than Applicants' priority date of March 27, 2003. To remove Sato et al's prior publication as section 102(a) prior art, Applicants submit herewith a verified English translation of their priority document. Section 112 support for present claims in the priority document is as shown in the following chart:

Present Claim	Support in Priority Document JP 2003-089021
Claim 1	Claim 1; [0010]-[0017]
Claim 2	Claim 2; [0017]
Claim 3	Claim 3; [0018]
Claim 4	Claim 4; [0019]
Claim 5	Claim 5; [0020]
Claim 6	[0021]
Claim 7	[0022]
Claim 8	[0023]
Claim 9	[0103]
Claim 10	[0103]
Claim 11	[0103]
Claim 12	[0097]
Claim 13	[0097]
Claim 14	[0097]
Claim 15	[0097]

Present Claim	Support in Priority Document JP 2003-089021
Claim 16	[0194]
Claim 17	[0206]
Claim 18	[0209]

In view of the above, Sato et al is prior art with respect to the present application solely under § 102(e).

To remove Sato et al as prior art under § 102(e) for purposes of § 103, Applicants provide a statement of common ownership, as follows:

Statement of Common Ownership:

The present application and Sato et al were, at the time the invention of the present application was made, commonly owned by Fuji Photo Film Co., Ltd. (now FUJIFILM Corp.)

In view of this statement of common ownership, Sato et al is disqualified as prior art for purposes of section 103 with respect to the present application. See 35 U.S.C. § 103(c).

Accordingly, the Examiner is respectfully requested to withdraw the section 103 rejection of claims 1-18 based on Sato et al.

In Paragraph No. 6, claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-23 of copending application no. 10/937,270 (hereinafter "Kodama '270").

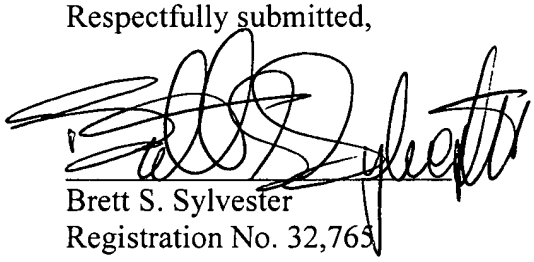
In Paragraph No. 7, claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-15 of Sato et al '282.

Applicants submit herewith Terminal Disclaimers to obviate these rejections.

Allowance is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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